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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,433	11/07/2000	Bruce K. Geist	PM021	9716

7590 12/15/2004
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EXAMINER

ZAND, KAMBIZ

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/707,433

Applicant(s)

GEIST ET AL.

Examiner

Kambiz Zand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 29-144 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,29-64,72-85,92-127 and 133-144 is/are rejected.
- 7) ☒ Claim(s) 65-71,86-91 and 128-132 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4,6,10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Claims 1 and 29-144** have been examined.
2. Request for correction of inventor name and the filing date has been approved and entered.

Specification

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 136-143 been renumbered as claims 137-144.

4. The disclosure is objected to because of the following informalities: Please update the cross-reference to related application on page 1 of the specification since the related applications have been patented, however related patent numbers are missing from the information on page 1.

Appropriate correction is required.

Information Disclosure Statement PTO-1449

6. The Information Disclosure Statement submitted by applicant has been considered. Please see attached PTO-1449.

Claim Objections

7. **Claims 1 and 29-144** are objected to because of the following informalities; and Examiner suggests the following corrections:

Claim 1:

- Please delete the phrase "first" from lines 4 and 7 of the claim since it implies other digital signatures (second, third, etc..) are present. However the claim language only disclose one digital signature.

Claims 29-144:

- Please delete the phrase "critical" from the language of the claims since the phrase "critical" is a relative term with relative meaning and it may create ambiguity.

Claim 136-137:

- It seems that claim 137 is continuation of claim 136 but has been numbered due a typo error. If not, claim 36 has to finish with a period,

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therefore please delete “; and” phrase from the last line of the claim and insert the phrase”.”.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. **Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the “authenticatable data string” phrases makes the claims indefinite and unclear in that neither method steps nor interrelationship of method steps are set forth in these claims in order to achieve the desired results expressed in the “authenticatable data string” phrases.

In claim 1, the “authenticatable” phrases makes the claims indefinite and unclear in that neither means nor interrelationship of means are set forth in these claims in order to achieve the desired results expressed in the “authenticatable” phrases.

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Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 1, 29-37, 39-51, 53-64, 72-85, 92-127 and 133-144** are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon et al. (6,289,323 B1).

As per claim 1 Gordon et al. (6,289,323 B1) disclose constructing a data string (see fig.2; col.4, lines 9-11); generating a digital signature based on the data string and a private key (see col.4, lines 34-40); obtaining a public key certificate from a certifying authority (see col.6, lines 44-54); and fixing at least some of the data string, the first digital signature and the public key certificate to the document (see fig.2; col.3-15).

As per claims 29-31, 37, 43-44, 48, 51, 60, 64, 75, 81, 93, 94, 100, 102, 103, 104, 106-109, 111-113, 115-119, 121-124 and 133-144 Gordon et al. (6,289,323 B1) disclose a first digital signature (encrypting over a digest using private key) (see fig.2; col.4, lines 9-43); a second digital signature (encrypting over a digest

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using private key) (see fig.2; col.4, lines 43-52) and a personal identification number (pin) (see col.4, lines 18-21); and a public key certificate including an authentic public key for validating said first and second digital signature (see fig.2; col.5, lines 4-14), wherein said first, second digital signature and said public key certificate are stored on said self-authenticating document (see fig.2; col.4, lines 9-67; col.5, lines 1-22). Gordon further teach bar code reader and data contained in a magnetic ink character recognition code line where the above information are stored in a bar code reader and all limitation set forth in the above claims (see col.4, lines 24-30, 55-57 and 65-67; col.5, lines 1-14; also see col.5-15). Also see col.3-15 for detailed.

As per claims 32, 33, 49, 50, 77, 78, 95, 101, 110 and 120 Gordon et al. (6,289,323 B1) disclose ASCII text that includes account name and address (see col.3-6; also ASCII is inherent within the bar code readers and scanners).

As per claims 34-36, 45-47, 76, 96 and 97 Gordon et al. (6,289,323 B1) disclose said document is a personal value/ commercial value such as personal check, identification card, SS number, credit card, passport, driver license, birth certificate, voter's registration card, bank check, business check, tickets, gift certificate, titles, currency, etc (see fig.7; col.2, lines 5-10; col.3-6 line11).

As per claims 39-42, 53-56, 79, 80, 98 and 99 Gordon et al. (6,289,323 B1) disclose a barcode format includes number of fields as recited in the above

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claims (see fig.2; col.4, lines 23-67; col.5, lines 1-14; col.6, lines 18-67; col.7, lines 36-52; col.8, lines 1-62).

As per claims 57 and 84 Gordon et al. (6,289,323 B1) disclose personal identification number is selected by the owner of said personal value document (see fig.7).

As per claims 58, 59, 62, 72-74, 85, 92 and 125-127 Gordon et al. (6,289,323 B1) disclose a third party responsible for printing and issuing said personal value document selects said personal identification number (see fig.7 for issuing and fig.9 for printing; col.3-15).

As per claims 61, 63, 82, 83, 105 and 114 Gordon et al. (6,289,323 B1) disclose said digital signature algorithm is an elliptic curve digital signature algorithm (ECDSA) (see col.6, lines 33-45).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) patent may not be obtained though the invention is not identically disclose or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

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matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 38 and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (6,289,323 B1) in view of Axelord et al (5,337,358 A).

As per claims 38 and 52 Gordon et al. (6,289,323 B1) disclose all limitation of the claims but do not disclose explicitly bar code format is PDF 417. However Axelord et al (5,337,358 A) disclose PDF-417 (see col.3, lines 31-35). It would have been obvious to one ordinary skilled in the art at the time the invention was made to utilize Axelord's PDF-417 in Gordon's barcode system in order to record a transaction including authentication of an identification card.

Allowable Subject Matter

14. **Claims 65-71, 86-91 and 128-132** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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U.S. Patent No. US (6,324,525 B1) teach settlement of aggregated electronic transactions over a network.

U.S. Patent No. US (6,202,157 B1) teach computer network security system and method having unilateral enforceable security policy provision.

U.S. Patent No. US (5,793,868 A) teach certificate revocation system.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kambiz Zand

12/09/04